

ESTTA Tracking number: **ESTTA253915**

Filing date: **12/09/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Home Depot U.S.A., Inc.
Granted to Date of previous extension	12/10/2008
Address	2455 Paces Ferry Road Atlanta, GA 30339 UNITED STATES
Attorney information	Richard J. Groos, Alicia Morris Groos FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVENUE, SUITE 2400 AUSTIN, TX 78701 UNITED STATES aotrademark@fulbright.com, agroos@fulbright.com, rgroos@fulbright.com, kpfertner@fulbright.com Phone:512.474.5201

### Applicant Information

Application No	77067004	Publication date	08/12/2008
Opposition Filing Date	12/09/2008	Opposition Period Ends	12/10/2008
Applicant	DE LEON ARIZPE, RUBEN Ocampo 462-A, Col La Fama Santa Catarina, 66100 MEXICO		

### Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Corrugated boxes
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### Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant does not have a bona fide intent to use the alleged mark; Alleged mark fails to function as a trademark

Attachments	HDPO121 notice of opposition.pdf ( 6 pages )(130353 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Alicia Morris Groos/
Name	Alicia Morris Groos
Date	12/09/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/067,004  
Published in the Official Gazette on August 12, 2008

HOME DEPOT U.S.A., INC.,	§	
	§	
Opposer,	§	Opposition No. _____
v.	§	
	§	
RUBEN DE LEON ARIZPE,	§	
	§	
Applicant.	§	

**NOTICE OF OPPOSITION**

Opposer Home Depot U.S.A., Inc. ("Opposer"), a Delaware corporation having its principal place of business at 2455 Paces Ferry Road, Atlanta, Georgia, 30339, believes that it will be damaged by registration of Application Serial No. 77/067,004 and hereby opposes the same under the provisions of Section 13 of the Lanham Act, 15 U.S.C. § 1063.

As grounds for opposition, Home Depot alleges the following:

1. Opposer operates The Home Depot® stores, and is the nation's largest home improvement retailer. The Home Depot enjoys a very strong national reputation with consumers and professionals in the home improvement industry. Opposer sells and distributes a wide variety of home improvement and flooring products, including saltillo tile, terrazzo tile, ceramic tile, and porcelain tile.
2. Applicant Ruben de Leon Arizpe ("Applicant") seeks to register "Saltillo tile" (stylized), Serial No. 77/067,004 for "corrugated boxes" in Class 16 ("Applicant's goods").
3. Applicant filed Application Serial No. 77/067,004 on December 19, 2006, listing Section 1(a), use in commerce, as the sole filing basis. At the time of filing, the application

stated that the alleged mark was first used in commerce at least as early as October 14, 1997. Applicant submitted as specimens two photographs of a box bearing Applicant's alleged mark. The photographed box displayed the words: "AUTHENTIC / Saltillo tile / NATURAL HAND MADE TILE."

4. On information and belief, the wording "Saltillo tile" on the photographed box indicates that the box contained or was intended to contain saltillo tile.

5. On April 17, 2007, the Examining Attorney for Serial No. 77/067,004 issued an Office Action refusing registration on the ground that the specimen depicted packaging for saltillo tiles, not Applicant's alleged goods, "corrugated boxes."

6. On October 16, 2007, Applicant submitted new specimens displaying the words "saltillo tile," but not the stylized alleged mark. On January 2, 2008, the Examining Attorney issued a final Office Action rejecting these specimens on the same ground.

7. On July 2, 2008, Applicant amended its application and listed Section 1(b), intent to use in commerce, as the sole filing basis. The application was then approved for publication and Opposer timely opposes same.

8. Since prior to Applicant's filing date, Opposer has been and is now engaged in the sale and distribution of tile, including saltillo tile, in interstate commerce.

9. On information and belief, Opposer and Applicant are competitors in the sale and distribution of saltillo tile.

10. On information and belief, "saltillo tile" is a generic or descriptive name for a type of tile.

11. On information and belief, Applicant filed Application Serial No. 77/067,004 to register "Saltillo tile" for "corrugated boxes" in an impermissible attempt to attain the exclusive

right to use the generic or descriptive term “saltillo tile” on packaging for saltillo tile. Applicant seeks to erect a barrier to competition by attempting to obtain trademark protection for a term that is otherwise a generic or descriptive term for tile of a certain appearance. Since Applicant would be unable to register “Saltillo tile” for clay tiles, his strategy is to obtain a registration for “corrugated boxes.”

12. On information and belief, on July 2, 2008, when Applicant amended its filing basis to Section 1(b), Applicant did not have a bona fide intent to use the alleged mark in commerce for the goods identified in the application. Registration should therefore be refused under 15 U.S.C. § 1051(b).

13. On information and belief, Applicant’s alleged mark is intended to be used for informational purposes on packaging for saltillo tiles and does not function as a trademark. Applicant does not intend to use the alleged mark for corrugated boxes. Registration should therefore under 15 U.S.C. §§ 1051, 1052 and 1127.

14. On information and belief, Applicant’s alleged mark directly indicates the goods, or directly conveys information concerning the function, characteristics, qualities, purpose and/or use of Applicant’s underlying goods and has not acquired distinctiveness through use in the marketplace. Registration should therefore be refused under 15 U.S.C. § 1052(e)(1).

15. In amending the filing basis for Application Serial No. 77/067,004 to Section 1(b), Applicant declared that he had “a bona fide intention to use” the alleged mark in commerce.

16. On information and belief, Applicant knew at the time of such declaration that he intended to use the alleged mark on packaging for saltillo tile, and that he did not intend to use the alleged mark for “corrugated boxes.”

17. On information and belief, Applicant's made such declaration in bad faith and in attempt to perpetrate a fraud upon the USPTO because Applicant knew that he was not entitled to registration.

18. Reasonably relying on the truth of such materially false statement, the USPTO approved Application Serial No. 77/067,004 for publication, resulting in the application being published on August 12, 2008.

19. Upon information and belief, Applicant's conduct constitutes fraud on the USPTO and therefore registration should be refused.

20. Registration of Applicant's alleged mark would be a source of damage to Home Depot, as the Application is an impermissible attempt to obtain the exclusive right to use the generic or descriptive term "saltillo tile" on packaging for saltillo tile, in an effort to stifle competition and prevent Home Depot and others from fairly using "saltillo tile" on packaging for the goods.

21. Registration of Applicant's alleged mark would be a source of damage to Home Depot and the public because Home Depot needs to indicate what is in a box containing saltillo tiles and consumers need to be able to rely on the indication.

22. Registration of Applicant's alleged mark would be a source of damage to Home Depot, as it would confer upon Applicant various statutory presumptions to which he is not entitled.

WHEREFORE, Home Depot requests that registration of Application Serial No. 77/067,004 be refused and this opposition be sustained.

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(17) is submitted herewith. If the amount is insufficient or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to the deposit account of Fulbright & Jaworski L.L.P., Account No.: 50-1212/HDPO:121/RJG.

Respectfully submitted,

Dated: December 9, 2008

By:




Richard J. Groos  
Alicia Morris Groos  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the NOTICE OF OPPOSITION has been served via First Class Mail to Applicant's attorney of record at the address below on this the 9th day of December, 2008:

Arturo Perez-Guerrero  
Law Offices of Arturo Perez-Guerrero  
P.O. Box 9024163  
San Juan, PR 00902-4163

  
Alicia Morris Groos